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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,684	12/17/2001	Kazuo Kuroda	Q67641	8061

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EXAMINER

WINDER, PATRICE L

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/015,684	Applicant(s) KURODA, KAZUO	
	Examiner Patrice Winder	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 18-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-17, drawn to an network game system including a search engine to search for an address where additional relevant information is located and users are not notified, classified in class 217, subclass 217.
 - II. Claims 18-23, drawn to a network game system including a search engine that retrieves additional content based on clues, classified in class 463, subclass 9.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as online gaming system including means to receive additional information without the features of Invention II. In applicant's remarks filed on October 11, 2005, page 12, invention II is describes as being a distinct embodiment of applicant's invention. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Newly submitted claims 18-23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: see paragraphs 1-4 above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al., USPN 6,669,564 (hereafter referred to as Young), in view of Pytlovany, USPN 6,690,992 (hereafter referred to as Pytlovany).

8. Regarding claim 1, Young discloses a network game system for operating on a network a game made up of basic content containing a basic program for executing

start of a game solely and one or more types of relevant content each containing a relevant program corresponding to the basic program for further advancing the game started by the basic program, the system comprising:

a content management section adapted to set an address of which users are not notified in one or more content providing servers each in which the relevant program is placed (i.e., CD-ROM carrying initial game episode and the user must download further game episodes, Young, column 6, line 52 - column 7, line 35 and column 10, line 44 - column 11, lines 10),

wherein the content providing server sends the relevant content placed in the content providing server to the user terminal in response to a download request made by the accessing user (Young, column 11, lines 11-63).

Young does not disclose an address for which a search is made by search means on the network from a user terminal. However, Pytlovany, in the same gaming field of endeavor, does disclose an address for which a search is made by search means on the network from a user terminal (Pytlovany, column 2, lines 1-24 and column 4, lines 10-50). It would have been obvious to one of ordinary skill in the art to incorporate a search engine, taught by Pytlovany, into the gaming system, taught by Young, in order to quickly find additional gaming data.

9. Regarding claim 2, Young-Pytlovany further discloses the relevant content has a check program for previously checking link possibility with the basic content or any other type of relevant content (Young, column 3, lines 15-47).

10. Regarding claim 3, Young-Pytlovany further discloses upon reception of the download request made by the accessing user, the content providing server checks a holding state of relevant content in the user terminal and checks link possibility between the relevant content held in the user terminal and the relevant content requested to be downloaded (Young, column 3, lines 15-47 and column 9, lines 51-67).

11. Regarding claim 4, Young-Pytlovany further discloses each of the content one or more types of relevant content for the accessing user and the content management section sets the address of which the users are not notified in the one or more content providing home pages (Young, column 3, lines 15-47) (Ptlovany, column 2, lines 1-24).

12. Regarding claim 5, Young-Pytlovany further discloses the content management section changes the address of the content providing home page with a lapse of time (Young, column 3, lines 15-47 and column 13, lines 43-67).

13. Regarding claim 6, Young-Pytlovany further discloses the content providing server determines unauthorized access to the content providing home page and if unauthorized access is made, changes the address of the content providing home page (Young, column 10, lines 1-43).

14. Regarding claim 7, Young-Pytlovany further discloses the content providing server limits the number of users for which the relevant content is to be provided from the content providing home page (Young, column 9, lines 21-67) .

15. Regarding claim 8, Young-Pytlovany further discloses the content management means comprises user information registration means for registering user information and enables the relevant content to be provided only for the registered users (Young,

column 10, lines 1-43).

16. Regarding claim 9, Young-Pytlovany further discloses to provide the relevant content for the user terminal, the content providing server performs mutual authentication processing with the user based on the user information and provides the relevant content for the user terminal after authenticating identification of the user (Young, col. 10, lines 1-43).

17. Regarding claim 10, Young-Pytlovany further discloses the content management means has a management server for managing the download enable state of the relevant content from the content providing home page and when terminating downloading the relevant content from the content providing home page belonging to the content providing server, the content providing server notifies the management server of the fact (Young, column 3, lines 15-47 and column 9, lines 51-67).

18. Regarding claims 11-17, claims 11-17 have similar limitations as claims 1-10. Therefore, they are rejected under Young-Pytlovany for the same reasons set forth in the rejection of claims 1-10 (Supra 1-10).

Response to Arguments

19. Applicant's arguments filed October 11, 2005 have been fully considered but they are not persuasive.

20. Applicant argues – “Even assuming that the combination of Pytlovany search engine with the young gaming system may result in this feature, there is no motivation to combine the references.”

- a. Young specifically suggested the utility of a search engine to find “more episodic content”, see column 13, lines 3-7.
21. Applicant argues – “The Young reference would thus teach away from adding a necessary search engine.”
- b. Young specifically taught using a search engine to assist in locating gaming content through the World Wide Web, see column 16, lines 46-50, 60-65.
22. Applicant argues – “The content section of claim creates network addresses where relevant programs are located which are then not given to users.”
- c. Being that Young taught a network gaming system wherein a user must go to web sites or third parties to find locate additional episodic content, applicant’s limitation of “an address of which users are not notified” is taught. The further “episodic content” provided by Young is not provided initially, thus “users are not notified” of relevant programs.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrice Winder
Primary Examiner
Art Unit 2145

January 3, 2006